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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,436	09/30/2003	Jeyhan Karaoguz	15037US02	5627
23446 7590 11/25/2008 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER DUFFIELD, JEREMY S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/675,436

**Applicant(s)**

KARAOGUZ ET AL.

**Examiner**

JEREMY DUFFIELD

**Art Unit**

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Miscellaneous***

1. Note: Examiner of record has changed for this application and art unit has changed from 2623 to 2427.

### ***Response to Arguments***

2. Applicant's arguments filed 02 October 2008 have been fully considered but they are not persuasive.

In response to applicant's arguments that the given reference does not teach "determining, at the first location...result in a match," Page 14, lines 3-9, the examiner respectfully disagrees. Goldman teaches tracking viewer behavior regarding the outputting, recording, etc. of a broadcasted video at a home entertainment system. An operator at a remote clearinghouse can determine the desired types of information to be included in the viewer behavior information. When a user at the home entertainment system requests a program from the program guide, predetermined characteristics of the program, i.e. channel ID, program ID, title, etc., are recorded. The remotely requested characteristics are matched against the characteristics recorded at the home entertainment system and when found, the matched data is sent to the clearinghouse. If there is no match in a requested characteristic and a recorded characteristic, then the data is not sent to the clearinghouse (Para. 27-29, 35-37). The claimed "media request" is taught by the viewing information containing, among a plurality of data, the channel ID, subscriber ID, program ID, and the current date and time. This shows the channel

and program requested by the subscriber who requested it at the date and time it was requested. Therefore, the aforementioned limitation is taught by Goldman.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldman (US PG Pub 2002/0112239).

With respect to Claim 1, the claimed "establishing at a first location, from a second location, at least one parameter related to monitoring media consumption activity of a user at a first location" is met by Goldman that teaches the requesting of specific viewer behavior information 98, containing type & volume of data pertaining to media consumption activity, from a user at a 1<sup>st</sup> location (home entertainment system 90) by a clearinghouse system 100, at a 2<sup>nd</sup> location (Figs. 1-3; paragraph [0037]). The claimed "receiving, at the first location, a media request from the user, the requested media having an associated set of pre-defined characteristics" is met by Goldman that teaches the tracking of viewer behavior information related to user at 1<sup>st</sup> location, 90, making a

request for media, whereby the identification of the requested media is made possible by information contained within an EPG (paragraph [0032-0034]).

The claimed "determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter" is met by Goldman that teaches a home entertainment system, 90, matching specific data requested by the clearinghouse system 100 with that of the data of the program being tracked (paragraphs [0037-0036]). The claimed "sending notification of the media request to a second location, via a communication network, if the determining results in a match; and refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match" is met by Goldman that teaches the transmission of only select viewer behavior information 98, from 1<sup>st</sup> location, home entertainment system 90, to a 2<sup>nd</sup> location, clearinghouse system 100 (Figure 2; paragraphs [0037] & [0043]).

With respect to Claim 2, the claimed "wherein the first location is associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN)" is met by Goldman that teaches Claim 1 and the use of an addressable set-top box, within home entertainment system 90, that sends select viewer behavior information using the Internet (paragraph [0010] & [0040]). The claimed "Internet protocol (IP) address" is not explicitly taught by the Goldman reference. The Examiner furthermore notes that the use of IP addresses is

necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

With respect to Claim 3, the claimed “wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure” is met by Goldman that teaches Claim 1 in which the communication network 110 can include a cable, optical, terrestrial antenna system, satellite system etc. (Fig1; paragraph [0029]).

With respect to Claim 4, the claimed “wherein the communication network is the Internet” is met by Goldman that teaches the use of an Internet connection by a user at the 1<sup>st</sup> location, home entertainment system 90, in sending pertinent viewer behavior information 98 (Fig.1; paragraphs [0040] & [0060]).

With respect to Claim 5, the claimed “wherein the media comprises one or more of audio, a still image, video, real time video, and data” is met by Goldman that teaches video data corresponding to broadcast 88 being delivered to a 1<sup>st</sup> user at home entertainment system 90 (Fig.1; paragraphs [0029] & [0035]).

With respect to Claim 6, the claimed “wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data” is met by Goldman that teaches the use of a display device 92 at a 1<sup>st</sup> location (home entertainment system 90) for the displaying of broadcast programming, such as video data (Fig. 1 & 2; paragraphs [0022], [0027], [0031], & [0035]).

With respect to Claim 7, the claimed “wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used” is met by Goldman that teaches a central clearinghouse 100 indicating specific viewer behavior information that it desired to be tracked, such as: channel ID, subscriber ID, program ID & title, city & state of channel, and the current date & time (paragraph [0037]).

With respect to Claim 8, the claimed “wherein the associated set of pre-defined characteristics comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, and/or a language” is met by Goldman that teaches the use of an EPG in making available data for viewer behavior information 98, the data pertaining to: provider of broadcast, type of broadcast, date & time of broadcast, origination of broadcast, manner in which broadcast is being

supplied, title of program, episode, director of program, actors, program ratings, etc. (paragraph [0034]).

Claim 9 is met as previously discussed with respect to Claim 1. In addition, with respect to the claimed "creating at least one record of the media request, at the second location; and sharing information derived from the at least one record with a third party" is met by Goldman teaching the use of a storage device 104 for the gathering of viewer behavior information 98 at the clearinghouse system 100, the creation of a viewer behavior information report 109, and the transmittal of 109 to a third party, signal source 80 (Fig. 3; paragraphs [0043] & [0048]).

Claim 10 is met as previously discussed with respect to Claim 2.

Claim 11 is met as previously discussed with respect to Claim 3.

Claim 12 is met as previously discussed with respect to Claim 4.

Claim 13 is met as previously discussed with respect to Claim 5.

Claim 14 is met as previously discussed with respect to Claim 6.

Claim 15 is met as previously discussed with respect to Claim 7.

Claim 16 is met as previously discussed with respect to Claim 8.



With respect to Claim 17, the claimed "wherein the third party is at least one of a third party media provider, a third party service provider, and a third party sales provider" is met by Goldman that teaches the method of Claim 9 and the transmittal of a viewer behavior information report 109 to a third party service provider, signal source 80 (Fig.3; paragraph [0048]).

With respect to Claim 18, the claimed "wherein the sharing uses the communication network" is met by Goldman that teaches the method of Claim 9 and the sharing of viewer behavior information report 109 with signal source 80 via the communication network 110 (Fig.3; paragraph [0048]).

Claim 19 is met as previously discussed with respect to Claim 1. In addition, Goldman teaches a 1<sup>st</sup> location, home entertainment system 90, which may consist of a addressable set top box {storage device 96, processor 94} & a television {display device 92} using an EPG for the selection of video data, and the transmittal of information related to media selected for media consumption {viewer behavior information 98- which may contain subscriber ID, channel ID, program ID and title, etc.}, via the internet, to server software {clearinghouse system 100} which stores sent info {storage device 96} (Figs.1-3; paragraphs [0027], [0033-0035], [0040-0042], & [0043]). The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

Furthermore, with respect to the claimed "the server software sending notification of a media request to a second location based on a determination as to whether a set of predefined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location" is met by Goldman that teaches the transmittal of compiled viewer behavior reports to numerous 2<sup>nd</sup> locations, home entertainment systems 90a-d, based upon whether or not select viewer behavior information 98, from home entertainment systems matches those requested by the clearinghouse system 100 (Figs.2, 3; paragraphs [0037], [0043],[0045]).

Claim 20 is met as previously discussed with respect to Claim 5.

Claim 21 is met as previously discussed with respect to Claim 6.

Claim 22 is met as previously discussed with respect to Claim 2.

Claim 23 is met as previously discussed with respect to Claim 3.

Claim 24 is met as previously discussed with respect to Claim 1.

Claim 25 is met as previously discussed with respect to Claim 7.

With respect to Claim 26, the claimed "server software that shares, with a third party, information derived from the received data" is met by Goldman that teaches the system of Claim 19, and the transmittal of a viewer behavior information report 109, by

clearinghouse system 100, to a third party service provider, signal source 80 (Fig.3; paragraph [0048]).

Claim 27 is met as previously discussed with respect to Claim 8.

Claim 28 is met as previously discussed with respect to Claim 1. Furthermore, Goldman teaches a 1<sup>st</sup> location, home entertainment system 90, which may consist of addressable set top box circuitry {storage device 96, processor 94, mass storage device 50} & a television {display device 92, 14} using an EPG for the selection of video data, and the transmittal of information related to media selected for media consumption {viewer behavior information 98- which may contain subscriber ID, channel ID, program ID and title, etc.}, via the internet, to server software {clearinghouse system 100} which stores sent info {storage device 104} (Figs.1-3, 6; paragraphs [0027], [0033-0035], [0040-0043], [0060], [0061], & [0065]). The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

Furthermore, with respect to the claimed "the software sending notification of a media request to a second location based on a determination as to whether a set of predefined characteristics associated with the requested media matches at least on parameter related to monitoring media consumption activity at the first location" is met by Goldman that teaches the transmittal of compiled viewer behavior reports to numerous 2<sup>nd</sup> locations, home entertainment systems 90a-d, based upon whether or not

select viewer behavior information 98, from home entertainment systems matches those requested by the clearinghouse system 100 (Figs.2, 3; paragraphs [0037], [0043],[0045]).

Claim 29 is met as previously discussed with respect to Claim 5.

Claim 30 is met as previously discussed with respect to Claim 6.

Claim 31 is met as previously discussed with respect to Claim 2.

Claim 32 is met as previously discussed with respect to Claim 3.

Claim 33 is met as previously discussed with respect to Claim 1.

Claim 34 is met as previously discussed with respect to Claim 7.

With respect to Claim 35, the claimed "wherein the software shares, with a third party, information derived from the received data" is met by Goldman teaching the use of a storage device 104 for the gathering of viewer behavior information 98 at the clearinghouse system 100, the creation of a viewer behavior information report 109, and the transmittal of 109 to a third party, signal source 80 (Fig. 3; paragraphs [0043] & [0048]).

Claim 36 is met as previously discussed with respect to Claim 8.

With respect to Claim 37, the claimed "wherein the software comprises server software" is met by Goldman teaching the use of a clearinghouse system 100 in the compilation/creation a viewer behavior information report (Fig.3; paragraphs [0043]-[0045]).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JEREMY DUFFIELD** whose telephone number is (571)270-1643. The examiner can normally be reached on Mon.-Thurs. 8:00 A.M.-5:30 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20 November 2008  
JSD

/Scott Beliveau/  
Supervisory Patent Examiner, Art Unit 2427